

REMARKS

I. Status of the claims

Claims 12-16, 18, 23-25, and 30 are pending. Claims 1-11, 17, 19-22, and 26-29 were previously canceled herewith without prejudice or disclaimer. Applicants reserve the right to file one or more continuing applications to the canceled subject matter. Claims 13, 14, 18, 23, and 30 have been amended for the reasons that follow.

Applicants acknowledge that claim 12 is allowed.

Applicants have made every effort to ensure that all trademarks are appropriately denoted as such in the specification, and have therefore duly amended the pertinent paragraphs accordingly. That is, Applicants have amended the paragraph bridging pages 3 and 4 so that “GenBank” is properly denoted as a registered mark; and also the paragraph bridging pages 11 and 12 so that “ECL” is properly denoted as a trademark.

Applicants thank Examiner Rawlings for extending the courtesy of a telephone discussion regarding this application on June 29, 2005. At that time, Examiner Rawlings acknowledged that Dr. Alonso’s declaration, submitted on February 11, 2005, with Applicants’ prior response, does indeed state the required affirmation in paragraph 4 (“*the amendatory material consists of the same material incorporated by reference in the [referencing application]*”). Accordingly, the declaration is sound and accurate.

Examiner Rawlings also indicated that amending the claims to recite a “malignant” cancer cell and clarifying that the monoclonal antibody of claim 30, subsection (i), is the one deposited under DSM ACC 2457, are appropriate after-final amendments.

**II. Dr. Alonso’s declaration correctly attests that
no new matter has been introduced into the application or into the claims**

Claims 13-16, 18, 23-25, and 30 are rejected under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the written description requirement. The rejection is a new matter rejection.

As noted in the preceding subsection, Dr. Alonso’s affidavit is sufficient to overcome the rejection because he *does* affirm that there is no “amendatory material” in the present application.

Accordingly, no new matter has been introduced into the claims. Applicants request, therefore, withdrawal of this rejection.

III. Claims 13, 14, 18, and 30 are amended to clarify that the method identifies a “malignant” cancer cell, thereby overcoming the allegation that the claims lack enablement for identifying a “benign” cancer cell

Claims 13-16, 18, and 30 are rejected under 35 U.S.C. § 112, first paragraph because the specification allegedly does not provide enablement for using the method for identifying the presence of a “benign” tumor.

To expedite prosecution, Applicants have amended claims 13, 14, 18, 23, and 30 to clarify that the claimed methods are drawn to the identification of the presence of a “malignant” cancer cell, which the Examiner acknowledges is enabled. See page 5, paragraph 10 of the Office Action dated April 6th. Accordingly, Applicants request withdrawal of this rejection.

IV. Claim 30 (i) is amended to clarify that the recited monoclonal antibody bears the accession number DSM ACC 2457, thereby obviating the rejection

Claim 30 is rejected under 35 U.S.C. § 112, first paragraph because it “is not interpreted to limit the monoclonal antibody to a monoclonal antibody that binds to the polypeptide of SEQ ID NO: 2.” Office Action at page 6.

To expedite prosecution, Applicants have amended claim 30 so that it is clear that the monoclonal antibody of subsection (i) is the antibody deposited under accession number DSM ACC 2457. This particular antibody binds to the polypeptide of SEQ ID NO: 2. Accordingly, Applicants believe that this clarification overcomes the rejection and respectfully request that it be withdrawn.

V. The combination of Martinez *et al.*, 1999, and Campbell does not teach or suggest the monoclonal antibody of DSM ACC 2457 and, therefore, claim 30 is not obvious

Claim 30 is rejected under 35 U.S.C. § 103(a) as allegedly obvious in light of Martinez *et al.*, Cancer Res. 59, pp. 5408-5411, 1999, in view of Campbell, Monoclonal Antibody Technology Laboratory Techniques in Biochemistry and Molecular Biology, Elsevier Science Publishers B.V.: Amsterdam, The Netherlands, Vol. 13, pp. 1-32. It would have been *prima facie* obvious, the Examiner says, to “produce a monoclonal antibody for use in determining the level of expression of Nup88 in tissue biopsy samples.” Office Action at page 8.

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No interpretation of the Martinez/Campbell combination, however, suggests the precise monoclonal antibody deposited under DSM ACC 2457, which is recited in claim 30. Accordingly, claim 30 is not obvious and Applicants, therefore, respectfully request withdrawal of this rejection.

VI. Conclusion

Applicants believe that the present application is in condition for allowance. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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